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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,013	04/08/2004	Paquita Erazo-Majewicz	10304	9303
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Hercules Incorporated Hercules Plaza 1313 North Market Street Wilmington, DE 19894-0001				
			EXAMINER MRUK, BRIAN P	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/07/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/821,013

Applicant(s)

ERAZO-MAJEWICZ ET AL.

Examiner

Brian P. Mruk

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 21-76 is/are pending in the application.
- 4a) Of the above claim(s) 46-62 and 76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21-45 and 63-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office action is in response to Applicant's amendment filed September 14, 2007. Applicant has amended claim 1. Claim 20 has been cancelled. Claims 46-62 and 76 remain withdrawn from consideration. Currently, claims 1-19 and 21-76 remain pending in the application.
2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper No. 20070306.
3. The objection of claims 17 and 20 are withdrawn in view of applicant's amendments and remarks.
4. The rejection of claims 1-19, 21-45 and 63-75 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Erazo-Majewicz et al, US 2003/0211952, is maintained for the reasons of record.
5. The rejection of claims 1-19, 21-45 and 63-75 under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Erazo-Majewicz et al, WO 03/095497, is maintained for the reasons of record.

6. The rejection of claims 1-19, 21-45 and 63-75 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-56 of U.S. Patent No. 7,067,499 is maintained for the reasons of record.

7. The provisional rejection of claims 1-19, 21-45 and 63-75 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-76 of copending Application No. 11/202,469 is maintained for the reasons of record.

## **NEW GROUNDS OF REJECTION**

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-19, 21-45 and 63-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the phrase "light transmittance of less than 72% at a wavelength of 600 nm" recited in instant claim 1 is not supported by the instant specification. The examiner notes that Table 9 on page 34 of the instant specification provides for compositions with a light transmittance

of 83.8, 71.6, 62, 57.7 and 43.5 at 600 nm, but this does not support the limitation "light transmittance of less than 72% at a wavelength of 600 nm" that is recited in instant claim 1. Appropriate correction and/or clarification is required.

Instant claims 2-19, 21-45 and 63-75 are rejected under 35 U.S.C. 112, first paragraph, for being dependent upon claim 1.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-19, 21-45 and 63-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. The limitation "wherein the personal care or household care composition containing 0.5% of the cationic, oxidized polysaccharide or derivative thereof has a light transmittance of less than 72% at a wavelength of 600 nm" recited in instant claim 1 renders the claim indefinite. The examiner asserts that the instant specification does not contain guidelines of how the light transmittance is measured, and thus, this limitation renders the claim indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of claim 1. Specifically, it is unclear what type of solution the cationic, oxidized polysaccharide or derivative is measured in (i.e. water, solvent, etc), how dilute the solution is, and what other components, if any, are also

present during the measurement. Therefore, the examiner asserts that this limitation renders the claim indefinite.

Instant claims 2-19, 21-45 and 63-75 are rejected under 35 U.S.C. 112, second paragraph, for being dependent upon claim 1.

### ***Response to Arguments***

13. Applicant's arguments filed September 14, 2007 have been fully considered but they are not persuasive.

Applicant argues that Erazo-Majewicz et al, US 2003/0211952, and Erazo-Majewicz et al, WO 03/095497, do not teach or suggest in general cationic oxidized polysaccharides that meet the molecular weight requirements of the instant claims. However, the examiner respectfully disagrees. Specifically, the examiner asserts that both Erazo-Majewicz et al references clearly teach cationic oxidized polysaccharides that have a molecular weight of 5,000-200,000, which are within the scope of the presently claimed invention.

Applicant further argues that Erazo-Majewicz et al, US 2003/0211952, and Erazo-Majewicz et al, WO 03/095497, each have a light transmittance in a 10% aqueous solution of greater than 80% at a light wavelength of 600 nm, which is outside the scope of the instant claims that require a light transmittance of less than 72% at a wavelength of 600 nm. However, the examiner respectfully disagrees. Specifically, as addressed in Paragraph No. 12 above, the examiner asserts that since it is unclear how applicant measured the light transmittance in the instant invention, that it is not an

inherent certainty that the compositions of the Erazo-Majewicz et al references have a light transmittance outside the scope of the presently claimed invention. It is noted by the examiner that both Erazo-Majewicz et al references clearly contain guidelines of how their light transmittance was measured (see paragraph 26 of Erazo-Majewicz et al, US 2003/0211952, which discloses that the measurement is taken with the cationic oxidized polysaccharides in a 10% aqueous solution). Furthermore, the examiner asserts that both Erazo-Majewicz et al references disclose similar cationic oxidized polysaccharides with identical molecular weights required in the instant claims, and therefore, asserts that the compositions would exhibit similar light transmittance, since products of identical chemical composition cannot have mutually exclusive properties.

Applicant argues that the double patenting rejections over claims 1-56 of U.S. Patent No. 7,067,499 and claims 1-76 of copending Application No. 11/202,469 are overcome in view of the amendments to instant claim 1. However, the examiner respectfully disagrees. Specifically, as addressed in Paragraph No. 12 above, the examiner asserts that since it is unclear how applicant measured the light transmittance in the instant invention, that it is not an inherent certainty that the compositions in the claims of U.S. Patent No. 7,067,499 and copending Application No. 11/202,469 have a light transmittance outside the scope of the presently claimed invention. Furthermore, the examiner asserts that U.S. Patent No. 7,067,499 and copending Application No. 11/202,469 claim similar cationic oxidized polysaccharides with identical molecular weights required in the instant claims, and therefore, asserts that the compositions

would exhibit similar light transmittance, since products of identical chemical composition cannot have mutually exclusive properties.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00 AM-5:30 PM).



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Bpm*

Brian P Mruk  
December 4, 2007

*Brian P. Mruk*

Brian P Mruk  
Primary Examiner  
Art Unit 1796